



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,961	07/05/2003	Christian E. Schafmeister	214001-01024-1-1	9015
3705	7590	07/29/2004	EXAMINER	
ECKERT SEAMANS CHERIN & MELLOTT 600 GRANT STREET 44TH FLOOR PITTSBURGH, PA 15219			DESAI, RITA J	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,961

Applicant(s)

SCHAFMEISTER, CHRISTIAN E.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-294 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-294 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to compounds of formula I , classified in class 548 and various subclasses.
- II. Claims 13-24 , drawn to a formula 2 , classified in class 548 and various subclasses.
- III. Claims 25-36 , drawn to a formula 3, classified in class 548 and various subclasses.
- IV. Claims 37-48 , drawn to formula 4 , classified in class 548 and various subclasses.
- V. Claim 49-60 , drawn to compounds of formula 5 classified in class 546 and various subclasses.
- VI. Claims 61- 72, drawn to compounds of formula 6 , classified in class 546 and various subclasses.
- VII. Claims 73-84 , drawn to compounds of formula 7 , classified in class 546 , and various subclasses.
- VIII. Claims 85-96 , drawn to compounds of formula 8 , classified in class 546 and various subclasses.
- IX. Claims 97-108, drawn to compounds of formula 9 , classified in class 546 and various subclasses.

Art Unit: 1625

- X. Claims 109-120 , drawn to compounds of formula 10 , classified in class 546 and various subclasses.
- XI. Claims 121-132 , drawn to compounds of formula 11 , classified in class 548 and various subclasses.
- XII. Claims 133-144 , drawn to compounds of formula 12 , classified in class 548 and various subclasses.
- XIII. Claims 145-156 , drawn to compounds of formula 13 , classified in class 548 and various subclasses.
- XIV. Claims 157-168 , drawn to compounds of formula 14 , classified in class 548 and various subclasses.
- XV. Claims 173-184 , drawn to compounds of formula 15 , classified in class 546 and subclass 124.
- XVI. Claims 185-196 , drawn to compounds of formula 16 , classified in class 546 and subclass 124.
- XVII. Claims 197-208 , drawn to compounds of formula 17 , classified in class 546 and various subclasses.
- XVIII. Claims 209-220 , drawn to compound of formula 18 , classified in class 546 and various subclasses.
- XIX. Claims 221-232 , drawn to compounds of formula 19 , classified in class 548 and various subclasses.
- XX. Claims 233-244 , drawn to compounds of formula 20 , classified in class 548 and various subclasses.

Art Unit: 1625

- XXI. Claims 245-256 , drawn to compounds of formula 21 , classified in class 546 and various subclasses.
- XXII. Claims 257-268 , drawn to compounds of formula 22 , classified in class 546 and various subclasses.
- XXIII. Claims 269-280 , drawn to compounds of formula 23 , classified in class 546 and various subclasses.
- XXIV. Claims 281-292 , drawn to compounds of formula 24 , classified in class 546 and various subclasses.
- XXV. Claims 169, 170 and 293 , drawn to a method of synthesizing bispeptides classified in various classes and subclasses.
- XXVI. Claims 171, 172, 294 drawn to another method of synthesizing bispeptides, classified in various classes and subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions has a different core with different substituents . Thus they have different bonding and properties with different modes of operations .

Inventions I-XXIV and XXV and XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

Art Unit: 1625

instant case the different inventions inventions XXV and XXVI are two different methods of synthesizing bis peptides and inventions I-XXIV are drawn towards compounds of different formulas.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for any of the Groups II- XXVI , restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Debra Anderson on 7/ 20/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1625

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the cancelled non-elected subject matter without prejudice in due course.

If applicant 's traverse on the grounds that the inventions are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art , the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday,9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai

Application/Control Number: 10/613,961
Art Unit: 1625

Page 7

Primary Examiner
Art Unit 1625

R.D.
July 26, 2004

R. Desai
7/26/04